

REMARKS

Claims 74, 75, 86, 88 and 90 have been amended to point out with greater clarity and particularity the subject matter regarded by the Applicants as their invention. Applicants respectfully submit that the amendments to Claims 74, 75, 86, 88 and 90 are supported in the Specification, particularly in Tables 1-3 at pages 60-66, wherein the inhibition constants resulting from the specific assays of the instant application are recorded for each of the Compounds 1-91 against CA I, CA II, CA IV and CA IX (MN/CA IX). Each of the amended claims now list exemplary compounds that specifically meet the limitations of the independent claim from which each depends, that is, Claims 74, 75 and 86 meet those of independent Claim 70, and Claims 88 and 90 meet those of independent Claims 67 and 69, respectively.

Applicants respectfully conclude that no new matter has been entered by any of the above amendments.

Withdrawal of 35 USC § 112, 1<sup>st</sup> ¶ Rejection

Applicants respectfully acknowledge with thanks the Examiner's withdrawal of the 35 USC § 112, first paragraph rejection of the pending Claims 67-70, 72-75 and 77-90.

NEW CLAIM OBJECTION

Claims 74, 75, 86, 88 and 90 stand objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel . . . , or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

[Emphasis added.] Applicants respectfully submit that the above amendments to Claims 74, 75, 86, 88 and 90 address the subject objection, by amending those claims to be in proper dependent form.

Claims 74, 75 and 86 depend on Claim 72 which depends from Claim 70. Independent Claim 70 states that the inhibitor is "a potent inhibitor" with an "inhibition constant  $K_i$  . . . determined to be less than about 50 nanomolar . . . , and wherein said inhibitor is "a more potent inhibitor of MN/CA IX enzymatic activity than of the enzymatic activity of CA IV." In accordance with the specific assay results recorded in Tables 1, 2 and 3 at pages 60-66 of the instant application, Compounds 1, 6, 11-14, 16-26, 28, 29, 39, 40, 42, 43, 54-59, 62 and 70 of Compounds 1-91 of amended Claim 74, Compounds 1, 6, 11-14 and 16-26 of Compounds 1-26 of amended Claim 75, and Compounds 28, 29, 39, 40, 42, 43, 54-59, 62 and 70 of Compounds 27-70 of amended Claim 86 have those characteristics of the inhibitor as described in independent Claim 70.

Claim 88 depends on Claim 87 which depends on Claim 67, and Claim 90 depends from Claim 89 that depends from Claim 69. Both independent Claims 67 and 69 indicate that the inhibitor is "a potent inhibitor" with an "inhibition constant  $K_i$  . . . determined to be less than about 50 nanomolar . . . , and wherein said inhibitor is "a more potent inhibitor of MN/CA IX enzymatic activity than of the enzymatic activity of each of . . . CA I, CA II and CA IV." In accordance with the specific assay results recorded in Tables 1, 2 and 3 at pages 60-66 of the instant application, Compounds 1, 6, 11-13, 16-19, 22-26, 28, 29, 39, 40, 55, 58, 59, 62 and 70 of Compounds 1-91 of amended Claims 88 and 90 have those characteristics of the inhibitor as described in independent Claims 67 and 69.

Applicants respectfully submit that Claims 74, 75, 86, 88 and 90 as amended are in proper dependent form, and respectfully request that the Examiner reconsider and withdraw the subject objection to those claims.

### **CONCLUSION**

Applicants respectfully acknowledge with appreciation that the Examiner stated: "Claims 67-70, 72-73, 77-85, 87 and 89 appear to be free of the prior art and are in condition for allowance." [Office Action page 3 (1<sup>st</sup> full ¶).] Applicants respectfully conclude that as Claims 74, 75, 86, 88 and 90 have been amended to be in the proper

dependent form, that all the pending claims, that is, Claims 67-70, 72-75 and 77-90 are in condition for allowance, and earnestly request that said claims be promptly allowed. If for any reason the Examiner feels that a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to telephone the undersigned Attorney for the Applicants at (415) 981-2034.

Respectfully submitted,



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